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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	P	ATTORNEY DOCKET NO.
09/099,823	05/19/98	BILLING		

023492
ABBOTT LABORATORIES
DEPT. 377 - AP6D-2
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HM12/0524

GOLDBERG EXAMINER

ART UNIT

PAPER NUMBER

05/24/01

21

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action	Application No.	Applicant(s)	
	09/099,823	BILLING-MEDEL ET AL.	
	Examiner	Art Unit	
	Jeanine A Enewold Goldberg	1655	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 May 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 22 January 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
 - (b) ☐ they raise the issue of new matter. (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

4. ☐ Applicant's reply has overcome the following rejection(s): _____.
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: none.
 - Claim(s) objected to: none.
 - Claim(s) rejected: 1-16, 30, 33, 35, 38-42 and 45-49.
 - Claim(s) withdrawn from consideration: 17-29, 31-32, 34, 36-37, 43-44.
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
11. ☐ Other:

Continuation of 3. NOTE: All previously pending claims have been cancelled and newly added claims 50-84 have been added.

Claims 64-66, 83 are drawn to kits containing nucleic acids comprising SEQ ID NO: 1-2, 5 and, positions 1-357 of SEQ ID NO: 4. Claims 67-72, 80-82 are drawn to purified polynucleotides comprising SEQ ID NO: 1, 2, 5, positions 1-357 of SEQ ID NO: 4. The scope of the claims have been amended to no longer recite the percentage language as previously presented. However, the claims still fail to meet the written description guidelines. The claims are drawn to nucleic acids comprising SEQ ID NO: 1, 2, 5 and positions 1-357 of SEQ ID NO: 4. These sequences are EST's, as provided on page 57 of the specification. The specification fails teach a representative number of species within the scope of the claim, as set out in Example 7 of the Written Description Guidelines.


Claim 52 raises new issues because, the claim recites "comprising position SEQ ID NO: 5". The claim does not set forth which positions of SEQ ID NO: 5 are claimed.

Claims 53-57 are indefinite because it is unclear what is meant by "corresponding to positions of SEQ ID NO: 1, 2, 1-357 of SEQ ID NO: 4 or 5" respectively. It is unclear what corresponding is intended to mean. Corresponding was not part of the previously filed claims.

Claim 84 (old claim 38) has been amended to recite an isolated DNA molecule comprising SEQ ID NO: 22. SEQ ID NO: 22 is not a DNA molecule. Further Conklin teaches a nucleic acid sequence, SEQ ID NO: 5, which encodes the polypeptide of SEQ ID NO: 22. Thus, Claim 84 requires further considerations.

Applicant's remarks and arguments are drawn to the proposed new claims. However, since these claims are not entered, the arguments are moot.

Thus, in light of the above notes, the amendment after final has not been entered.


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